

REMARKS

Applicants' Representative thanks Examiner R. Cook for the helpful and courteous discussion of December 13, 2001.

Claims 25-27 are pending.

I. Affirmance Of Telephonic Response To Restriction Requirement

Applicants affirm the election of Group II, claims 25-27.

II. The Rejections Under The First Paragraph Of 35 U.S.C. § 112

Applicants thank the Office for withdrawing the rejections under the first paragraph of § 112, as noted in the Interview Summary for the interview held on December 13, 2001.

III. The Rejection Of The Claims Under 35 U.S.C. § 112, 2nd Paragraph

Claim 25-27 stand rejected as indefinite under the second paragraph of § 112.

The Office asserts that there is no antecedent basis in these claims for the term "a second hair revitalizing agent" (Office Action, page 3, last two lines).

Applicants respectfully traverse. The term "a second hair revitalizing agent" imparts no indefiniteness to the claims. The specification refers repeatedly to the compounds of the invention as "hair revitalizing agents" (see, e.g., page 13, lines 18 and 24) and discloses that "the compounds can be administered with other hair revitalizing agents" (page 15, lines 8-9). A person of skill in the art would thus recognize that by implication the compound of element (i) is the "first" hair revitalizing agent. Applicants draw the Office's attention to U.S. Patent No. 6,239,164, which issued from parent U.S. Patent Application No.

09/369,860, and in which claims 21-24 contain the identical language. The Federal Circuit has reprimanded the USPTO for not recognizing its own precedent in rejecting claims under 35 U.S.C. § 112. In re Cortright, 49 U.S.P.Q.2d 1464, 1467 (Fed. Cir. 1999). The Office recognized, in allowing the parent case, that the term “a second hair revitalizing agent” would present no ambiguity to a person of skill in the art, and should follow that precedent in the present application. Applicants therefore request that the Office withdraw this rejection.

IV. The Rejection Of Claims 25-27 Under 35 U.S.C. § 101 Over U.S. Patent No. 6,239,164

Claim 25-27 stand rejected under 35 U.S.C. § 101 for statutory double patenting over claims 22-24 of U.S. Patent No. 6,239,164 (“the ‘164 patent”). The Office asserts that Applicants are claiming the same invention as that of claims 22-24 of the ‘164 patent. See Office Action, page 4, 3rd paragraph.

Applicants respectfully traverse.

As noted in the Office Action, this ground of rejection applies where the claims being compared are drawn to identical subject matter. See Office Action, page 4, 1st paragraph (citing *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894), *In re Ockert*, 114 U.S.P.Q. 330 (C.C.P.A. 1957), and *In re Vogel*, 164 U.S.P.Q. 619 (C.C.P.A. 1970).

Base claim 22 of the ‘164 patent, and by extension dependent claims 23-24, contains limitations that are absent from claims 25-27 of the present application. Those additional limitations preclude a rejection under § 101 for same invention double patenting, because the

claims being compared do not claim identical subject matter. Applicants request that the Office withdraw this ground of rejection.

If the Office maintains this ground of rejection, Applicants would be willing to amend claim 25 to remove "phenyl" from the definition of R₄ to further prosecution. Because claim 25 is lengthy and complex, Applicants request, if this ground of rejection is maintained, that the Office enter an Examiner's Amendment to delete "phenyl" from the definition of R₄ in claim 25 (see Preliminary Amendment filed on April 5, 2001, Appendix 3, page A-81, last line).

V. The Request For Identification Of Related Cases

The Office requested that Applicants identify related cases (Office Action, page 4, penultimate paragraph). Applicants have filed concurrently herewith an Information Disclosure Statement listing related pending applications and issued patents.

VI. References Cited But Not Received By The Office

The Office noted that certain references cited in a previously-filed Information Disclosure Statement were not considered by the Office because the references were not received (Office Action, page 4, last paragraph). Applicants have submitted those missing references concurrently herewith, and have listed the references on a separate Form 1449 for the Office's convenience.

VII. CONCLUSION

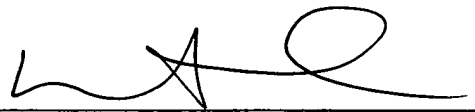
Applicant submits that the pending claims are now in condition for allowance. If the Office has questions, the Office is invited to call Applicants' Representative directly at (202) 974-6018.

Please charge or credit Deposit Account No. 12-2475 for all fees as needed.

Respectfully submitted,

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